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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,759

06/23/2005

Eva-Maria Leppanen

59643.00602

9073

32294 7590 03/02/2010
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EXAMINER

RECEK, JASON D

ART UNIT

PAPER NUMBER

2442

MAIL DATE

DELIVERY MODE

03/02/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/530,759</p>	<p>Applicant(s) LEPPANEN ET AL.</p>	
	<p>Examiner JASON RECEK</p>	<p>Art Unit 2442</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-31.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Asad M Nawaz/
Primary Examiner, Art Unit 2455

Continuation of 11. does NOT place the application in condition for allowance because: The declaration of prior invention has been considered but is ineffective to overcome the prior art reference used in the rejection. It is not clear from a review of the declaration and its exhibits if the Applicant is attempting to show prior reduction to practice or conception, due diligence, and a subsequent reduction to practice (either actual or constructive).

Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. See MPEP 715.07.

Applicant's remarks (pg. 2) states that the invention was "conceived" prior to 10/1/02. Thus, assuming that applicant attempts to show prior conception, due diligence, and a subsequent reduction to practice, the 37 CFR 1.131 Declaration filed on February 12, 2010 is ineffective for the following reasons:

i. The prior conception has not been clearly established because there is no statement of facts showing a possession of the claimed invention. Specifically, applicant has not pointed out how the Invention Report (exhibit) reads on the claims, especially the portion of the claim that Sylvain was relied upon for teaching.

ii. Due diligence has not been clearly established because the affidavit leaves gaps of time unaccounted for between each recited event, and applicant's remarks only mention "reasonable diligence". First, the emails (exhibit) only cover the time period between 9/24/02 and 9/29/02. Diligence must be shown from the effective date of the reference, in this case 10/1/02, until reduction to practice (constructive - filing date of 10/9/02). Second, applicant states "reasonable diligence was conducted" (pg. 2 of remarks). This is not the standard, the MPEP requires "due diligence" from prior date to subsequent reduction to practice or filing of the application. See. 37 CFR 1.131(b).

Assuming that applicant is attempting to show actual reduction to practice, the declaration is ineffective for the following reasons:

iii. The prior actual reduction to practice has not been clearly established because there is no statement of facts showing a possession of the claimed invention prior to the effective date of the reference. Applicant's remarks did not state that the 131 Declaration attempts to show actual prior reduction to practice. Furthermore, the declaration does state the invention actually existed, it states the invention was "conceived" prior to 10/1/02 (paragraph 4). With respect to the Invention Report, there are no embodiments described, illustrations of the aspects of the invention or proof that it works for its intended purpose. Instead, the report is merely a description of a problem and solution which if anything tends to show conception but not actual reduction to practice.

For these reasons, the declaration filed 2/12/10 is ineffective. Therefore, claims 1-31 are rejected as set for in the final office action dated October 26th 2009.